

II. REMARKS

Claims 1-20 are pending in this application. By this amendment, claims 1, 7, 15 and 17 have been amended. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, the specification is objected to. Applicants have removed the language in the claim that allegedly necessitates the amendment to the specification. Claim 17 has been rejected under 35 U.S.C. §101 as allegedly containing non-statutory subject matter. Claims 1-20 are rejected under 35 U.S.C. §112, first and second paragraph as allegedly failing to comply with the written description requirement and for allegedly being indefinite. Claims 1-8, 11-13, 15-16, and 18-19 are rejected under 35 U.S.C. §102(b) as being anticipated by Shi et al. (US patent no 5,875,296), hereafter “Shi.” Claims 9-10, 14, 17, and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shi. These objections and rejections are respectfully traversed for the reasons stated below.

A. REJECTION OF CLAIM 17 UNDER 35 U.S.C. §101

The Office has asserted that claim 17 is directed to non-statutory subject matter. Applicants have amended claim 17 to include a computer device. Applicants assert that this amendment complies with the Office’s interpretation of statutory subject matter. Accordingly, Applicants request that the rejection be withdrawn.

B. REJECTION OF CLAIMS 1-20 UNDER 35 U.S.C. §112

The Office has asserted that claims 1-20 fails to satisfy the written description requirement and is indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office objects to use of the word “directly” in the claims. In response, Applicants have removed the word “directly” from the claims. Accordingly, Applicants request that the rejection be withdrawn.

Applicants, however, respectfully submit that this amendment, as well as others previously made, is meant to highlight one difference from Shi taught in the original specification, that is, that the web pages for which the indicator is stored do not have to be accessed as a result of a login. Rather, one desire of the invention is to prohibit unauthorized use of readily accessible web page elements by web pages other than those that are authorized by the owner of the elements. Accordingly, Applicants respectfully request the Office’s help in articulating this distinction in the claims.

B. REJECTION OF CLAIMS 1-8, 11-13, 15-16, AND 18-19 UNDER 35 U.S.C. §102(b)

In the Office Action, claims 1-8, 11-13, 15-16 and 18-19 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Shi et al. (US patent no 5,875,296), hereafter Shi. Applicants respectfully submit that Shi does not teach each and every feature of the claimed invention. For example, with respect to independent claim 1, and similarly claimed in independent claims 7 and 15, Applicants respectfully submit the Shi fails to disclose every time a request is made from a client for a web page hosted by a web server, storing an indicator that said client has requested the web page hosted by said web server. In contrast, Shi teaches that its

indicator is stored upon login and not every time the request is made for a web page hosted by the web server. Accordingly, Applicants request that the rejections be withdrawn.

With further respect to independent claim 1, and similarly claimed in independent claims 7 and 15, Applicants respectfully submits the Shi also fails to disclose that the element of said web page is eliminated from use by another web site than that of the web server. Rather, the login system of Shi is meant to determine whether a requesting user is authorized and not whether a web site that is attempting to use an embedded element is authorized. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

With still further respect to independent claim 1, and similarly claimed in independent claims 7 and 15, Applicants respectfully continue to submit the Shi also fails to disclose responsive to a request from a client for an element of said web page that is stored in a separate file from the web page and displayed as an embedded element of said web page. To this extent, in contrast to Shi, the claimed invention deals specifically with elements of web pages that are stored separately from the base web page but that are displayed on the web page in conjunction with the web page. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

With respect to dependent claims, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicants submit that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicants respectfully request withdrawal of this rejection.

IV. CONCLUSION

In addition to the above arguments, Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

Applicants respectfully submit that the application is in condition for allowance. Should the Examiner believe that anything further is necessary to place the application in better condition for allowance, he is requested to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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Date: May 5, 2008

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